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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,414	08/03/2000	KENICHI MORITA	15162/02390	9594

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EXAMINER

YUSSUF, SAJID

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 04/15/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/631,414

Applicant(s)

MORITA ET AL.

Examiner

Sajid A Yussuf

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/03/2000-03/08/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/08/03/2000</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 11-223622, filed on August 06 1999.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. ***Claim(s) 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Mori et al. (6,466,330).***

6. As per claim 1 Mori teaches a data communication apparatus capable of connecting a plurality of communication lines, (See abstract and Column 1 Lines 43-46). Mori further teaches of a specification unit for specifying a transmission destination; wherein the specification and transmission unit is a relay controller and a transmission unit for transmitting a plurality of its own

address data corresponding to each of the plurality of communication lines to the specified transmission destination, (See abstract and Column 1 Lines 46-59).

7. As per claim 2 Mori teaches the claimed invention as described in claim 1 above and furthermore discloses the transmission unit to transmit the address data together with the image data; wherein the transmission of address and image is interpreted as electronic mail (See Column 1 and 2 Lines 60-66 and 1-14 respectively).

8. As per claim 3 Mori teaches the claimed invention as described in claims 1-2 above and furthermore discloses a receiving unit for receiving at least one address data or another data communication apparatus, (See Column 2 Lines 45-50), as well as a recording unit for recording the address data received by the receiving unit, (See Column 4 Lines 50-60).

9. As per claim 4 and 8 Mori teaches the claimed invention as described in claims 1-3 above and furthermore discloses a controller for controlling the use of received/recorded address data; wherein the controller is also the relay controller (See Column 2 Lines 45-53).

10. As per claim 5 Mori teaches a method of data communication by specifying a transmission destination and transmitting a plurality of its own address data corresponding to each of a plurality of communication lines to the specified transmission destination, (See Column 4 Lines 50-64).

11. As per claim 6 Mori teaches a data communication apparatus capable of connecting a plurality of communication lines comprising a receiving unit for receiving at least one of the address data of another data communication apparatus, a recording unit for recording the address data received by the receiving unit, (See Column 2 Lines 38-58). Mori also teaches a transmission unit for transmitting at least one of its own address data to the address recorded by the recording unit, (See Column 4 Lines 50-64).

12. As per claim 7 Mori teaches the claimed invention as described in claim 6 above and furthermore discloses the said own address data are corresponding to each of the plurality of communication lines, wherein the own address lines are interpreted as being a fax destination number for telephony transmission or electronic mail for internet transmission, (See Column 7 Lines 15-29).

13. As per claim 9 Mori teaches a method of data communication comprising a receiving at least one of the address data of another data communication apparatus, as well as recording the received address data and transmitting its own address data to the recorded address, (See Column 7 Lines 7-20).

Response to Arguments

14. Applicant's arguments filed 03/12/04 have been fully considered but they are not persuasive.

15. As per claims 1,5 Applicant states, "Mori does not disclose, teach, or suggest a device that transmits a plurality of its own addresses to another device."

16. Examiner respectfully disagrees as Mori does indeed disclose a device which transmits a plurality of its own addresses to another device, specifically the relay controller included within the apparatus in which the address information is included, (See Column 1 Lines 58-67 & Column 2 Lines 1-7); wherein the plurality of its own address can be a phone number in which to send the image through a telephone network or an e-mail address to send the image through a packet based network. One has to grasp that fact that an address of the sender is always known when sending e-mail as well as a fax "image" through a telephone line. The senders address appears on the header of the receiving machine as well as an e-mail in the "from" field. Therefore, it is concluded that Mori does include an apparatus that transmits a plurality of its own addresses (i.e., Phone number/e-mail address) to another device.

17. As per claim 3 Applicant states "Mori does not disclose, teach, or suggest a device that transmits a plurality of its own address data and receives at least one address data from a data communication apparatus at the transmission destination."

18. Examiner respectfully disagrees as Mori does indeed disclose a device which transmits a plurality of its own addresses to another device, specifically the relay controller included within the apparatus in which the address information is included, (See Column 1 Lines 58-67 & Column 2 Lines 1-7); wherein the plurality of its own address can be a phone number in which to send the image through a telephone network or an e-mail address to send the image through a packet based network. One has to grasp that fact that an address of the sender is always known when sending e-mail as well as a fax "image" through a telephone line. The sender's address appears on the header of the receiving machine as well as an e-mail in the "from" field. Therefore, it is concluded that Mori does include an apparatus that transmits a plurality of its own addresses (i.e., Phone number/e-mail address) to another device. Furthermore Mori discloses receiving at least one address data from a data communication apparatus at the transmission destination, which again is needed in order to correctly, transmit data from one apparatus to another. An acknowledgement needs to occur in order to verify that the address that the image is being sent to is correct and to verify if the receiving device is a destination unit or a relay unit. Therefore, address of the receiving unit needs to be verified before information is sent out through multiple communication means, (See Column 2 Lines 26-60).

19. As per claims 6,9 Applicant states, "Mori does not disclose, teach, or suggest a device that receives at least one address data from another data communication apparatus and transmits a plurality of its own address data to the recorded address/other device."

20. Examiner respectfully disagrees as Mori discloses a device that receives at least one address data from another data communication apparatus and transmits a plurality of its own address data to the recorded address/other device, (See Column 8 Lines 1-49). Mori teaches that during a relay

operation between the two systems the header information contains the address information of the sender and receiver; wherein the relay stations are not necessarily the destination stations as the image is transported from relay station to relay station the destination address is checked to determine if the destination has been reached. Therefore a relay device receives at least the destination address from the sending apparatus as well as the send apparatuses' address and in turn retransmits to either a destination or another relay station its address as well as the destination address (i.e., plurality of its own address data to the recorded address/other device).

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

22. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

23. Claim(s) 10-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mori et al. (6,466,330).

24. As per claim(s) 10 Mori teaches the claimed invention as described in claim(s) 1-9 above and furthermore discloses a memory (i.e., working memory) for storing the address data, (See Column 6 Lines 7-19).

25. As per claim(s) 11 Mori teaches the claimed invention as described in claim(s) 1-10 above and furthermore discloses the controller is adapted to search (selecting) the recording unit for an address corresponding to the specified transmission destination, (See Column 1 Lines 40-67 & Column 2 Lines 1-12).

26. As per claim(s) 13 Mori teaches the claimed invention as described in claim(s) 1-11 above and furthermore discloses the recording unit is adapted to update previously recorded addresses with the received address data; wherein the recording unit is a memory space used to capture or store addresses and furthermore when arriving at each terminal whether be it a relay terminal or destination terminal the address requires an update as stored in memory in order to traverse through a network in order to arrive to a destination station, (See Column 9 Lines 5-55).

27. As per claim(s) 14 Mori teaches the claimed invention as described in claim(s) 1-13 above and furthermore discloses receiving from the specified transmission destination address data corresponding to the address of at least two communication lines; wherein the communication lines are either a PSTN or Network Line (NL), to which the specified transmission destination is connected, (See Column 4 Lines 9-30); and storing the received address data in a memory; wherein the system controller stores the address from the "from" field in the system memory in order to transmit to the relay or destination station, (See Column 9 Lines 18-25).

28. As per claim(s) 15 Mori teaches the claimed invention as described in claim(s) 1-14 above and furthermore discloses obtaining an address of the specified transmission destination by retrieving from a memory, (See Column 6 Lines 8-25); wherein arriving at each terminal whether be it a relay terminal or destination terminal the address for the next station is stored in memory in order to traverse to the destination station, a plurality of addresses corresponding to the specified transmission destination and selecting one of the retrieved plurality of addresses, (See Column 7 Lines 15-39).

29. As per claim(s) 16 Mori discloses a first memory (i.e., working memory) for storing a plurality of addresses at which the data communication device can be reached, (See Column 6 Lines 7-19); a communication controller (i.e., data transmission controller) for communicating with another data communication device over one of the plurality of communication lines, wherein the communication controller is adapted to send to the other data communication device the plurality of addresses, (See Column 6 Lines 46-55).

30. As per claim(s) 17 Mori teaches the claimed invention as described in claim(s) 16 above and furthermore discloses the communication controller is further adapted to receive from the other data communication device a plurality of addresses at which the other data communication device can be reached, (See Column 6 Lines 46-55).

31. As per claim(s) 18 Mori teaches the claimed invention as described in claim(s) 16-17 above and furthermore discloses a second memory for storing the received addresses, (See Column 6 Lines 17-19).

32. As per claim(s) 20 Mori discloses a communication controller capable of coupling the data communication apparatus to a plurality of communication lines, there being an address associated with each communication line at which the data communication apparatus can be reached, (See Column 6 Lines 46-55); and a processor programmed to cause the communication controller to transmit data to another device over one of the plurality of communication lines, and to transmit the addresses associated with the plurality of communication lines to the other device over the one communication line, (See Column 6 Lines 7-12).

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

35. Claims 12 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent No. 6,466,330 and Mori hereinafter) in view of Suzuki et al. (US Patent No. 6,005,677 and Suzuki hereinafter).

36. As per claim(s) 12 Mori discloses the controller is adapted to retrieve an address from the recording unit when an address corresponding to the specified transmission destination is found, (See Column 6 Lines 7-32).

However, Mori does not explicitly teach prompting a user to provide an address when an address corresponding to the specified transmission destination is not found.

Suzuki teaches prompting a user to provide an address when an address corresponding to the specified transmission destination is not found; wherein it is interpreted that the user provides the update for an address (See Column 4 Lines 56-67 & Column 5 Lines 1-13).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Mori with the teachings of Suzuki to include prompting a user to provide an address when an address corresponding to the specified transmission destination was not found with the motivation to designate whether the internet or the general exchanging network is to be used at the time of performing the operation of transmitting the image information and it is further necessary to confirm whether the correspondence partner

terminal is connected to the internet or the general exchanging network, (See Suzuki Column 1 Lines 33-39).

37. As per claim(s) 19 Mori discloses the claimed invention as described above.

However, Mori does not explicitly teach a user interface adapted to accept from a user an identification of another data communication device; and a processor programmed to retrieve from the second memory a plurality of addresses for the user identified data communication device.

Suzuki teaches a user interface adapted to accept from a user an identification of another data communication device; wherein the identification of "another" device is its destination phone number or e-mail address, (See Column 4 Lines 16-25), and a processor (i.e., system controller) programmed to retrieve from the second memory (i.e., parameter memory) a plurality of addresses for the user identified data communication device; wherein the addresses are stored in memory with the e-mail (i.e., data), (See Column 3 Lines 53-67 & Column 9 Lines 1-10).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Mori with the teachings of Suzuki to include a user interface adapted to accept from a user an identification of another data communication device; and a processor programmed to retrieve from the second memory a plurality of addresses for the user identified data communication device with the motivation to provide for facsimile device comprising local area network communication controlling means for exchanging data between the facsimile device and the terminal of a correspondence partner through a local area network connected to an internet. An exchanging network communication controlling means is provided for exchanging image information between the facsimile device and the terminal of the correspondence partner through an exchanging network in accordance with a predetermined facsimile transmitting procedure. Telephone number converting table means registers telephone numbers used to place a call by use of the exchanging network and a group of addresses for transmitting signals by use of the local area network, for the terminals of the respective correspondence partners. At the time of performing the transmitting operation, when a designated telephone number has been already registered in the telephone number converting table means, an address corresponding thereto is

looked up, and image information is transmitted to the looked up address by use of the local area network communication controlling means, (See Suzuki Column 1 Lines 42-62).

Conclusion

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajid A Yussuf whose telephone number is (703) 305-8752. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM and Alternate Fridays.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

40. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajid Yussuf
Patent Examiner
Technology center 2100
14 April 2004


RUPAL DHARIA
SUPERVISOR, PATENT EXAMINER